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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/442,646	11/18/1999	TOSHIHISA SARUTA	4947-0087-2	6214

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EXAMINER

WALLERSON, MARK E

ART UNIT PAPER NUMBER

2626

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/442,646

Applicant(s)

SARUTA ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 6-8, 16-18 and 23 is/are allowed.
- 6) ☐ Claim(s) 1-5, 9-15, 19-22 and 24 is/are rejected.
- 7) ☐ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 6/30/04.
2. This application has been reconsidered. Claims 1-25 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 3, 4, 5, 9, 10, 11, 12, 13, 14, 15, 19, 20, 21, 22, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook (U.S. 6,565,181).

With respect to claims 1, 2, 9, 10, 11, 12, 14, 19, 20, 21, and 22, Silverbrook discloses a method of determining whether a storage unit included in an ink cartridge is normal (column 166, lines 7-31), wherein the ink cartridge is detachably attached to the printer, comprising reading a piece of ink related information (state data) that has been registered in advance in a

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predetermined format from the storage unit (column 166, lines 20-46); identifying whether the read-out information satisfies the predetermined format so as to determine whether the storage unit is normal or not normal if the information has been destroyed (altered) (column 167, lines 29-64; column 168, lines 1-13; column 174, lines 23-37; and column 207, lines 20-48).

Silverbrook also discloses a display (15).

With regard to claims 4 and 13, Silverbrook discloses discontinuing a printing operation if the storage is not normal (column 147, line 60 to column 148, line 19).

With respect to claims 5, 15, and 24, Silverbrook discloses the state data includes the month of manufacture of the ink cartridge (column 257, lines 62-64).

Allowable Subject Matter

5. Claims 6-8, 16-18, and 23 are allowed.
6. Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 6/30/04 have been fully considered but they are not persuasive. Applicant submits that *Silverbrook* does not disclose determining whether a storage unit is not normal if a read-out piece of ink related information is destroyed. The Examiner respectfully disagrees.

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Applicant stated that only information that has support in the parent application (U.S. 6,362,868) can be considered as prior art. Accordingly, the Examiner will cite the pertinent parts of that prior art in addressing Applicant's comments.

Silverbrook discloses reading consumable state information (which reads on ink related information) from the storage and determining whether this information has been tampered with (column 157, lines 30-48; column 158, lines 22-67; column 159, lines 46-62; column 199, lines 17-23; column 205, lines 57-65; column 228, lines 39-54, and column 249, lines 1-28).

Applicant submits that "altered" is not synonymous with "destroyed". Again, the Examiner disagrees. The Examiner reads "altering" as being the same as "destroying", since the original state has been compromised.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626

MARK WALLERSON
PRIMARY EXAMINER

